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09/849,971	05/08/2001	Linda Ann Roberts	BS00-338	1307

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EXAMINER

SING, SIMON-P

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 07/02/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/849,971

Applicant(s)

ROBERTS ET AL.

Examiner

Simon Sing

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-10 and 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Epler et al. US Patent No. 5,825,867.

1.1 Regarding claim 1, Epler discloses a method of enhanced call waiting. Epler teaches:

receiving a telephone from a caller while the called party is engage in another call with a third party (column 4, lines 43-45);

prompting the caller to enter a priority code, and alerting the called party if the priority code entered is valid (column 5, lines 33-60); and

establishing communication between the caller and the called party if the called party so desires (column 1, lines 26-38).

1.2 Regarding claim 2, Epler teaches that the priority code is unique to the caller party such as the caller's calling line ID (column 6, lines 13-18).

Art Unit: 2645

1.3 Regarding claim 3, Epler teaches that the priority code may be another telephone number associated with the called party, provided to the caller by the called party (column 6, lines 8-13).

1.4 Regarding claim 4, Epler teaches that a priority alert signal is a regular call waiting tone (column 5, lines 56-60).

1.5 Regarding claims 5 and 6, Epler teaches prompting the caller to leave a message if no priority code is entered, or the priority code entered does not match (column 5, lines 39-42).

1.6 Regarding claim 7, Epler discloses a method of enhanced call waiting. Epler teaches:

receiving a telephone from a caller while the called party is engaged in another call with a third party (column 4, lines 43-45);

prompting the caller to enter a priority code, and alerting the called party if the priority code entered is valid (column 5, lines 33-60); and

establishing communication between the caller and the called party if the called party desires so (column 1, lines 26-38).

Epler further teaches using multiple priority codes [telephone numbers associated with the called party] to generate distinctive rings for indicating different levels of priorities (column 6, lines 5-13, 24-28).

1.7 Regarding claim 8, as discussed in claim 7, each different priority code [telephone number] associates with different priority level (column 5-13, 24-28).

1.8 Regarding claim 9, as discussed in claim 7, it is inherent that the called party provides the different priority codes [telephone numbers] to the caller (column 6, lines 5-13, 24-28).

1.9 Regarding claim 10, as discussed in claim 7, each different priority code [telephone number] associates with different priority level (column 5-13, 24-28).

1.10 Regarding claim 20, Epler discloses a method of enhanced call waiting. Epler teaches:

receiving a telephone from a caller while the called party is engage in another call with a third party (column 4, lines 43-45);

prompting the caller to enter a priority code, and alerting the called party if the priority code entered is valid (column 5, lines 33-60); and

establishing communication between the caller and the called party if the called party desires so (column 1, lines 26-38).

Epler further teaches associating the called party with a plurality of priority codes [telephone numbers], to generate distinctive rings corresponding different level of priorities (column 6, lines 5-13, 24-28).

1.11 Regarding claim 21, as discussed in claim 20, each different priority code [telephone number] associates with different priority level (column 5-13, 24-28).

1.12 Regarding claim 22, as discussed in claim 20, it is inherent that the called party provides the different priority codes [telephone numbers] to the caller (column 6, lines 5-13, 24-28).

1.13 Regarding claim 23, as discussed in claim 20, each different priority code [telephone number] represents a different priority level (column 5-13, 24-28).

2. Claims 1-4 and 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Eisdorfer, US Patent No. 5,636,269.

2.1 Regarding claim 1, Eisdorfer discloses a method of intelligent call waiting.

Eisdorfer teaches:

receiving a telephone from a caller while the called party is engage in another call with a third party (column 2, lines 9-10; column 4, lines 53-57);

prompting the caller to enter a priority code (column 2, lines 38-45; column 5, lines 9-17);

alerting the called party if the priority code entered is valid (column 3, lines 2-7; column 5, lines 17-20); and

establishing communication between the caller and the called party if the called party desires so (column 1, lines 16-20; column 2, lines 15-24).

2.2 Regarding claim 2, Eisdorfer teaches that the priority code is unique to the caller (column 3, lines 2-5).

2.3 Regarding claim 3, since the priority code is stored in the called party's database, it is inherent that the priority code is provided to the caller by the called party (column 3, lines 2-7; column 5, lines 3-20).

2.4 Regarding claim 4, Eisdorfer teaches that a priority alert tone is a regular call waiting tone (column 3, lines 15-21).

2.5 Regarding claim 11, Eisdorfer discloses a system for call waiting in figure 1, comprising:

- a Service Switch Point (SSP) 18 in communication with telephone 10, wherein SSP 18 detects an incoming call to telephone 10 from a caller at telephone 14, while telephone 10 is in communication with telephone 12 (column 4, lines 53-57);

- a Service Control Point (SCP) 24 in communication with SSP 18, wherein the SCP 24 is adapted to review information associated with telephone 10 (column 5, lines 1-8), wherein SSP 18 queries SCP 24, and SCP 24 instructs SSP 18 to prompt the caller for a priority code (column 5, lines 5, lines 1-17), then the SCP 24 instructs SSP

Art Unit: 2645

18 to interrupt the communication between telephones 10 and 12 with a call waiting signal (column 5, lines 17-20) and connecting telephone 14 to telephone 10 if the user of telephone 10 so desires (column 1, lines 16-20; column 2, lines 15-24).

2.6 Regarding claim 12, Eisdorfer teaches that the SSP 18 is provisioned with a trigger (column 4, lines 63 to column 5, line 3).

2.7 Regarding claim 13, Eisdorfer teaches that the trigger is a busy trigger (column 4, lines 63 to column 5, line 3).

2.8 Regarding claim 14, Eisdorfer teaches that a priority alert signal may be a regular call waiting tone (column 3, lines 15-21).

2.9 Regarding claim 15, Eisdorfer discloses a method of intelligent call waiting.

Eisdorfer teaches:

receiving a telephone from a caller [telephone 14] while the called party [telephone 10] is engaged in another call with a third party [telephone 12] (column 4, lines 53-57);

querying a database accessible to a service control point (SCP) about service information, including at least on priority code [PIN] with the called party's telephone number (column 5, lines 1-8);

prompting the caller to enter a priority code (column 5, lines 9-17);



alerting the called party if the priority code entered is valid (column 5, lines 17-20; column 3, lines 2-7); and

establishing communication between the caller and the called party if the called party so desires (column 1, lines 16-20; column 2, lines 15-24).

2.10 Regarding claim 16, Eisdorfer teaches that that Service Switching Point (SCP) 18 comprises a trigger that is associated with telephone 10 (column 4, lines 63-67; column 5, lines 1-3).

2.11 Regarding claim 17, Eisdorfer teaches that the trigger is one of a termination trigger and a terminating busy trigger (column 4, line 63 to column 5, line 3).

2.12 Regarding claim 18, Eisdorfer teaches that the priority code is unique to a particular caller (column 3, lines 2-5).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Eisdorfer, US Patent No. 5,636,269 in view of Epler et al. US Patent No. 5,825,867.

Eisdorfer teaches that using a plurality of call waiting signals to alert a called party (column 3, lines 15-21), and a caller may input a priority indicator to indicate a call is a very important or a less important one (column 2, lines 48-57). Eisdorfer fails to specifically teach that the priority code is one of several priority codes available to the caller and each the several priority codes represents a different priority level.

However, Epler discloses a method of enhanced call waiting. Epler teaches using multiple priority codes [telephone numbers associated with the called party] to generate distinctive rings for indicating different levels of priorities (column 6, lines 5-13, 24-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Eisdorfer's reference with the teaching of Epler, so that the priority code would have been one of several codes each represents a different level of priority, and would have alerted the called party with different alerting signals for indicating different priority levels, because such a modification would have enabled the called party to identity the priority level from its call waiting signal and to respond accordingly.

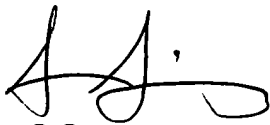
### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM.

Art Unit: 2645

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



S.S.

06/27/2003

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

